

REMARKS

I. CLAIM CHANGES

The withdrawn composition claims 1 to 18 have been canceled, because rejoinder under M.P.E.P. 821.04 is not possible for these claims, even with further amendments, since the restriction requirement has been made final and they have been withdrawn from consideration by the Office Action mailed on November 28, 2007.

II. COMMON OWNERSHIP OF THE ABOVE-IDENTIFIED APPLICATION AND U.S. PATENT 6,582,679, STEIN, ET AL

U.S. Patent 6,582,679, Stein, et al, was assigned 100 % to Wella AG, as evidenced by the front cover of that U.S. Patent.

The above-identified U.S. Patent Application was owned 100 % by Wella AG at the time the applicants' invention was made. The front cover of DE 102 34 801.4, the DE priority document for the above-identified U.S. Patent Application, shows that the DE priority document was owned 100 % by Wella AG. Thus at the time the applicants' invention was made (the DE priority date), the subject matter of the above-identified U. S. Patent Application 10/628,060 was owned 100 % by Wella AG or subject to an obligation of assignment to Wella AG.

Furthermore the inventors assigned 100 % of the above-identified U.S. Patent Application to Wella AG. The assignment was executed on July 25, 2003 and duly recorded in the USPTO on November 3, 2003. The reel/frame numbers are 014650/0572.

In accordance with the requirements of M.P.E.P. 706.02 (I)(2), the undersigned states that the above-identified U.S. Patent application and the U.S. Patent of Stein, et al, were, at the time the applicants' invention was made, owned 100 % by, or subject to an obligation of assignment to, Wella AG. Thus the reference and the above-identified application were commonly owned.

III. LEGAL REASONS FOR WITHDRAWAL OF THE 103 REJECTION

Claims 25 to 32 were rejected as obvious under 35 U.S.C. 103 (a) over Stein, et al, US Patent 6,582,679, in view of Birkel, et al, US Patent 6,475,475.

The Stein, et al, U.S. Patent is only a valid prior art reference under 35 U.S.C. 102 (e) (e.g. see the Office Action mailed April 1, 2009). The reasons that Stein, et al, is only a prior art reference under 35 U.S.C. 102 (e) are the following: it was issued only one month prior to the U.S. filing date of the above-identified U.S. Patent Application, July 25, 2003. Furthermore U.S. Patent Application, Ser. No. 09/968,102, from which US 6,582,679 issued, was only published on Sept. 5, 2002, which is less than one year prior to the U.S. filing date of the above-identified US Patent Application. Thus the published patent application, Ser. No. 09/968,102, also is not a statutory bar.

In addition, a certified English translation of the DE priority document 102 34 801.4 for the above-identified U.S. Patent Application has been filed previously in the above-identified U.S. Patent Application together with an amendment dated December 26, 2006. This certified English translation shows that applicants are entitled to July 31, 2002 as their "date of invention" under 35 U.S.C. 102 and 103. Thus Stein, et al, is also not a valid prior art reference under 35 U.S.C. 102 (a).

For the aforesaid reasons Stein, et al, would only be a valid prior art reference against the claims of the above-identified U.S. Patent Application under 35 U.S.C. 102 (e), since the U.S. filing date of Ser. No. 09/968,102 is earlier than the date of invention established by applicants' DE priority document 102 34 801.4.

However, as indicated in section I above regarding common ownership, the above-identified U.S. Patent Application of Maillefer, et al, was owned 100 % by Wella AG, or subject to an obligation of assignment to Wella AG, at the time that the invention was made. Thus the exception according to 35 U.S.C. 103 (c) applies, and the rejection under 35 U.S.C. 103 should be withdrawn on these legal grounds according to M.P.E.P. 706.02 (I).

Since the exception under 35 U.S.C. 103 (c) applies, withdrawal of the rejection of claims 25 to 32 as obvious under 35 U.S.C. 103 (a) over Stein, et al, US Patent 6,582,679, in view of Birkel, et al, US 6,475,475, is respectfully requested.

IV. TECHNICAL REASONS FOR WITHDRAWAL OF THE 103 REJECTION

Claims 25 to 32 were rejected as obvious under 35 U.S.C. 103 (a) over Stein, et al, US Patent 6,582,679 (called "Stein" herein below), in view of Birkel, et al, US Patent 6,475,475 (called "Birkel" herein below).

I. Applicants' Claim Method

The single independent method claim 28 requires application of a significantly more specific hair wax composition than the previous independent method claims. The applied hair wax composition is limited to a composition that contains:

- (a) 20 to 60 wt. % of water;
- (b) from 10 to 50 wt. % of a monohydric alcohol with 2 to 3 carbon atoms;
- (c) from 0 to 5 wt. % of a polyhydric alcohol with 2 to 5 carbon atoms;
- (d) from 10 to 30 wt. % of a nonionic emulsifier; and
- (e) from 5 to 30 wt. % of at least one wax;

in which a weight ratio of emulsifier to wax is greater than 1.

Furthermore it is critical to set the hair or put the hair in a hairstyle according to method claim 28 within a time interval immediately after applying the composition during which the hair is stickier than during a subsequent time interval.

B. Scope and Content of the Prior Art

Stein discloses wax or waxy compositions for improving the hold of a hairstyle and conditioning hair (column 1, lines 56 to 57) containing:

- (a) at least one wax or wax-like substance;
- (b) at least one non-volatile hydrophobic oil that is liquid at room temperature; and
- (c) at least one easily volatilized hydrophobic substance that is liquid or gaseous at room temperature (column 2, lines 23 to 34). The composition can be a sprayable or foamable composition (column 3, lines 26 to 33), which can be a non-aerosol or aerosol composition.

The compositions are either a soft solid pan wax or an aerosol or non-aerosol spray wax (column 1, line 58, to column 2, line 7).

However the compositions of Stein contain **only** up to 10 percent by weight of water or a lower alcohol with 2 to 3 carbons (column 6, lines 45 to 52). There is no other disclosure in Stein, generic or specific, that suggests amounts of water and/or alcohol with 2 to 3 carbon atoms that are greater than 10 wt. %. The examples in columns 7 and 8 do not contain any water or lower alcohols. The major liquid ingredients besides the optional emulsifiers are hydrophobic

liquids. The aerosol spray wax compositions contain a hydrophobic propellant (column 4, line 40, and column 5, lines 5 and following), such as a hydrocarbon, and do not contain a water-soluble propellant. The liquid oil ingredient is hydrophobic oil (see column 5).

Birkel discloses hair treatment compositions containing a special combination of two polymeric ingredients including a terpolymer of vinyl pyrrolidone, vinyl caprolactam and a basic acrylamide monomer and at least one polymer with an anionic or anionizable group (column 1, lines 47 to 58). Special benefits result from this particular combination of polymeric ingredients. Preferred polymers have a solubility of up to 5 wt. % in water because they form water solutions (column 3, lines 39 to 42).

The hair treatment compositions of Birkel can be in several different embodiments or forms, such as hair foam, hair lotion, or hair gel (see column 5), but may also optionally be in the form a hair wax composition according to column 5, lines 47 to 59, which contains a **water-insoluble** waxy substance.

Column 4, lines 6 to 8, of Birkel do teach that their generic aqueous, alcoholic or aqueous-alcoholic compositions containing the polymer composition may preferably contain at least 10 wt. % of water and also amounts of lower alcohols. Furthermore the examples in columns 6 and following do contain large amounts of water over 90 wt. %, but these examples are not hair wax compositions and do not contain any wax or waxy ingredients.

However there is no teaching regarding how the amounts of water in their compositions vary between different forms of their composition in Birkel. For example, it is well known that a solid hair wax does not contain any water and thus one skilled in the art would not consult Birkel for guidance regarding amounts of water that could be included in hair wax compositions, because Birkel contains no specific teaching regarding the amounts of water than can be included in their hair wax compositions. Their disclosure regarding hair wax compositions at column 5, lines 47 to 59, provides no disclosure regarding amounts of water or alcohol that can be included in hair wax compositions.

Thus only Stein provides guidance regarding the amounts of water that can be included in hair wax compositions that contain hydrophobic wax or waxy substances and/or the amounts and types of surfactant that are required to accompany a hydrophobic wax or waxy ingredient in an aqueous composition.

C. Reasons for the Obviousness Rejection

The alleged reason that the subject matter of claim 28 would be *prima facie* obvious from the combined subject matter of Stein, et al, and Birkel, et al, is presented on page 6 of the Office Action and is quoted here:

"A person of ordinary skill in the art would have been motivated to modify Stein, et al, method by further administering a higher concentration of water and alcohol as taught by Birkel, et al, to produce the hair wax, because it is *prima facie* obvious to combine two compositions each of which is taught in the prior art to be useful for same purpose in order to form a third composition that is to be used for very the same purpose; the idea of combining them flows logically from their having been individually taught in the prior art; thus, the claimed invention which is a combination of two known organic solvents set forth *prima facie* obvious subject matter. See *In re Kerkhoven*, 205 USPQ 1069.

The mere fact that two different compositions from two different prior art disclosures are used for a similar purpose does not disclose or suggest that one skilled in the art would be enabled by their combined disclosures to combine or mix them together. That ignores the differing chemistry and physical properties of the ingredients.

Stein discloses compositions that include hydrophobic ingredients, which would not be compatible with large amounts of water (for example, see the examples of Stein, which do not include any water in columns 7 and 8). The compositions of Stein, et al, can include up to 20 wt. % of nonionic surfactants to improve washability of the composition from the hair (column 6, lines 10 to 15), but nonionic surfactants are not especially hydrophilic and certainly not as hydrophilic as cationic and anionic surfactants. However the sprayable compositions of Stein only include hydrophobic liquids according to their disclosures and utilize hydrophobic propellants and solvents.

Stein limits the amount of water or lower alcohols with 3 carbon atoms or less to 10 wt. % or less according to column 6, lines 48 to 51. There is no other disclosure in Stein, generic or otherwise, that suggests that useful compositions could be formed with their predominantly hydrophobic ingredients, which contain more than 10 wt. % of water or the said lower alcohols.

The KSR Supreme Court Opinion suggests several tests for obviousness (M.P.E.P. 2143) including an obvious-to-try test which provides a valid reason to reject a claimed invention for obviousness under KSR, **provided that** a limited number of possibilities that have predictable results are available and known to

one of ordinary skill in the art. Several of the other tests, such as the test for combining known elements, also require that the outcome of the combination should be predictable (MPEP 2143).

Although obviousness does not require absolute predictability, at least some degree of predictability is required. See M.P.E.P. 2143.03 and *In re Rinehart*, 189 U.S.P.Q. 143(C.C.P.A. 1976). The chemical arts, in contrast to the mechanical arts, are generally somewhat unpredictable despite the advances of recent years. Here in the case of the instant claims at issue no disclosures of Birkel would motivate or suggest to one of ordinary skill in the cosmetic arts that the amounts of water in the hair wax compositions of Stein could be increased well above the upper limit of 10 wt. % disclosed in Stein, because Birkel does not disclose limits for the amounts of water and/or alcohol for their specific embodiments that are hair wax compositions. One of ordinary skill in the art knows that the amount ranges for solvents, such as water and/or lower alcohols, vary greatly depending on the form of the composition, e.g. solution, lotion, gel, solid wax or spray wax composition. Without such specific disclosure in Birkel for their hair wax embodiments, one skilled in the art would conclude that Birkel is not relevant to the issue of how much water could be included in a hair wax composition that is made with a water-insoluble waxy substance so that that composition can in fact be manufactured, stored, and applied in a convenient manner without phase separations that make it inconvenient or impossible to apply.

Thus it is suggested that the only relevant disclosure in the combined subject matter of Stein and Birkel regarding the amounts of water and/or lower alcohols is the disclosure in column 6 of Stein that the hair wax compositions cannot have more than 10 wt. % of water or alcohols with 2 to 3 carbon atoms.

Accordingly the combined disclosure contains teaching of doing the opposite from the invention claimed in applicants' method claim 28, i.e. applying a hair wax composition containing from 20 to 60 wt. % of water to the hair according to step a). A reference that teaches the opposite from the claimed invention cannot be employed to establish a case of *prima facie* obviousness under 35 U.S.C. 103.

The emulsifier limitations of step a of claim 28 are critical to the claimed method and facilitate the use of the larger amounts of water. The emulsifier limitations are not suggested by either prior art references.

The compositions of Stein are either solid waxes or spray wax compositions that contain minimal amounts of water and thus Stein would lead one skilled in the art away from the claimed invention. The following U.S. Court opinion regarding "leading away from the claimed invention" is applicable here:

"A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994).

Clearly Stein would lead one skilled in the cosmetic arts away from applying compositions containing 20 to 60 wt. % of water and wax to the hair.

Wax-containing compositions with the limitations according to step a of claim 28 have the desirable stickiness properties that facilitate step c of claim 28.

Hence it is respectfully submitted that a case of *prima facie* obviousness would not be established by the combined prior art disclosures of Stein, et al, and Birkel, et al, even if Stein, et al, were a valid prior art reference (which it is not because the exception under 35 U.S.C. 103 (c) applies).

Accordingly withdrawal of the rejection of pending claims 25 to 32 as obvious under 35 U.S.C. 103 (a) over Stein, et al, US Patent 6,582,679, in view of Birkel, et al, US Patent 6,475,475, is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or corrected in formal respects to put this case in condition for final allowance, then it is requested that such amendments or corrections be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing the case to allowance the Examiner should contact the undersigned at the telephone number provided below.

In view of the foregoing, favorable allowance is respectfully solicited.

Respectfully submitted,



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